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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,206	06/05/2001	Tsuyoshi Yamamoto		4030

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EXAMINER

HOANG, TU BA

ART UNIT

PAPER NUMBER

3742

DATE MAILED: 09/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/873,206

Applicant(s)

YAMAMOTO ET AL.

Examiner

Tu Ba Hoang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/JP00/06749, filed on December 1, 1999.

***Drawings***

Figure 13 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "99" as indicated on page 8 for the "subject". Should "9" be "99" as shown in Figure 9? It is further noted that the "optical fiber coupler 97" must also be clearly pointed in Figure 10. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. A legible copy of the foreign patent application No. Hei 7-259796 listed on page 1 is requested for proper consideration.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is so vague and cannot be clearly understood. This claim is an omnibus type claim. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Claim 1 is intended to recite an optical measurement device but there are no structural recitations or limitations to make up the device but merely the functional languages such as "to optically measure...", "to display an image...", "to designate...", and "to display...". Claim 1 is incomplete for omitting essential elements that make up the claimed device and such essential elements are needed for performing specified functions set forth.

In claim 2, there are insufficient antecedent bases for "the measurement amount" recited at lines 15-16, "the measurement amount variation or time information" recited at lines 16-17, "the position" recited at line 18 in the claim.

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Claims 4 and 10 are so vague as for the same reason set forth in claim 1 above as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph. The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 as being best understood are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Maki et al (JP 09019408) cited by the Applicants. Maki et al shows an optical measurement device comprising a measurement portion 2a-2d for measuring object substance within a measurement region of a subject or living body surface 6, a display portion 13 for displaying images based on signals from the measurement object substance wherein the display portion 13 includes a plurality of display portions T1...T3 as shown in Figure 3, a light receiver 8a-8f arranged on the surface for detecting light from the surface, a designator 9a-9h for designating a portion of the light receiver, and a computer unit 11 including a keyboard unit and a pointer..

Claims 1-9 as being best understood are further rejected under 35 U.S.C. 102(b) as being clearly anticipated by Maki et al (US 5,803,909). Maki et al shows all features of the claimed invention (Figure 2) including a measurement portion for measuring object substance within a measurement region of a living body surface, a display portion 13 for displaying images based on signals from the measurement object substance wherein the display portion 13 includes a plurality of display portions as shown in Figures 4 and 13, a light receiver arranged on the surface for detecting light from the surface, a designator for designating a portion of the light receiver, and a computer unit 11 including a keyboard unit and a pointer.

Claim 10 as being best understood is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kupershmidt (US 5,448,992). Kupershmidt shows all features of the claimed invention including optical fibers that are passed through a sensor 28 made from a piezoelectric element.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Yamashita et al (US 6,240,309), Kawaguchi et al (US 5,419,320), and Chance (US 6,397,099).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Ba Hoang whose telephone number is (703) 308-3303. The examiner can normally be reached on Mon-Fri from 8:30am to 5:00pm.

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The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 872-9301.

tbh

September 24, 2002



Tu Ba Hoang  
Primary Examiner